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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,867	03/04/2002	Hiroaki Sato	00449.00012	3965

22907 7590 11/17/2004

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WASHINGTON, DC 20001

EXAMINER

GENACK, MATTHEW W

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2/3

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/086,867	SATO, HIROAKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew W. Genack	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 6-9, 12-13, 17-20, 23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Valentine, U.S. Patent No. 5,815,808.

Regarding claims 1, 12, 23, and 25, Valentine discloses a mobile communication apparatus, a public land mobile network such that the PLMN 10 reads on the claimed mobile communication apparatus of claims 1, 23, and 25 because PLMN 10 is an apparatus for providing mobile communications among mobile phone users (Abstract, Fig. 1). A stored screening list, in conjunction with a setting module within the mobile station, are used to allow incoming telephone calls from telephone numbers that the user deems allowable, and to bar incoming telephone calls from telephone numbers that the user deems unallowable (Column 3 Lines 15-19, Column 8 Lines 34-45). The first information stored in the mobile communication apparatus is the screening list, while the second information received from the network is calling telephone number. Furthermore, Valentine teaches the use of the invention in the context of international roaming telephony (Column 5 Lines 1-6, Column 6 Lines 9-22).

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Regarding claims 2, 7-8, 13, and 18-19, Valentine discloses the use of country code information as well as network code information in the decision-making process (Column 6 Lines 9-30).

Regarding claims 6 and 17, Valentine teaches that the decision to allow or bar an incoming telephone call is based on information corresponding to the caller, e.g., said caller's telephone number. A comparison is made between the stored screen list and the telephone number of the incoming telephone call; if the number of the calling party is on the screening list, then the call is allowed, else if the number of the calling party is not on the list, then the call is blocked (Column 8 Lines 34-45).

Regarding claims 9 and 20, Valentine discloses the acceptance of an incoming telephone call when said telephone call comes from a telephone number on the stored screening list, and rejection of an incoming telephone call when said telephone call comes from a telephone number not on the stored screening list (Abstract).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 and 14-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine.

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Regarding claims 3 and 14, Valentine discloses all of the limitations of claims 1 and 12.

Valentine does not expressly disclose the use of removable integrated circuits in the storage unit for storing the screening list.

Examiner takes official notice that the use of integrated circuits in the storage devices of mobile switching stations was well known in the art. Further, any integrated circuit is removably connected to the system in which it is used because it may be unsoldered and removed as needed.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use integrated circuits in a mobile switching network 40 (see Fig. 1) for storing the multiple screening lists. The modification is obvious since using IC chips is the trend in the telecommunication industry.

Regarding 4-5 and 15-16, Valentine discloses all of the limitations of claims 1 and 12, as outlined above.

Valentine does not expressly disclose an invention in which the decision to allow or block an incoming telephone call is based on the date and time of the incoming telephone call.

In Valentine's description of the background of the invention, it is stated that the barring of incoming telephone calls from certain telephone numbers may be barred based on time (Column 1 Lines 56-59).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to enhance the invention of Valentine by adding the feature in which a call is either blocked or allowed depending on the time the call is made.

One of ordinary skill in the art would be motivated to make this enhancement because of the convenience given to the user when he has the ability to block calls from certain numbers at certain times of day or on certain days of the week.

5. Claims 10, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine in view of Gossman *et. al.*, U.S. Patent. No. 6,317,594.

Regarding claims 10 and 21, Valentine discloses all of the limitations of claims 1, 9, and 12, as outlined above.

Valentine does not expressly disclose the feature whereby an incoming call may be diverted to a network voice mail service, nor the feature whereby the calling party is diverted to local voice mail service (whereby the voice message is recorded and stored in the called mobile telephone).

Gossman *et. al.* discloses call-screening functionality whereby an incoming telephone call, may be, among other options, forwarded to a voice mail system (in other words, associated with the fixed network) or forwarded to local voice mail of the called mobile telephone (in other words, recorded and stored on the mobile telephone) (Column 16 Lines 33-64).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to add to the invention of Valentine a feature whereby the user

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has the option of forwarding an incoming telephone call to a network voice mail service or to local voice mail of the called mobile telephone as taught by Gossman.

One of ordinary skill in the art would have been motivated to make this modification because the use of voice mail to screen telephone calls is a convenience that is well known in the art.

Regarding claim 24, Valentine discloses the use of country codes and network codes in the call screening process (Column 6 Lines 9-30). Furthermore, Valentine discloses the practice of either accepting or ignoring an incoming telephone call based on a comparison of a list of acceptable telephone numbers and the telephone number from which the incoming telephone call originates from (Column 1 Lines 53-58, Column 3 Lines 15-19, Column 8 Lines 34-45).

Valentine does not expressly disclose the feature whereby an incoming call may be diverted to a network voice mail service, nor the feature whereby the calling party is diverted to local voice mail service (whereby the voice message is recorded and stored in the called mobile telephone).

Gossman *et. al.* discloses call-screening functionality whereby an incoming telephone call, may be, among other options, forwarded to a voice mail system (in other words, associated with the fixed network) or forwarded to local voice mail of the called mobile telephone (in other words, recorded and stored on the mobile telephone) (Column 16 Lines 33-64).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to add to the invention of Valentine a feature whereby the user

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has the option of forwarding an incoming telephone call to a network voice mail service or to local voice mail of the called mobile telephone.

One of ordinary skill in the art would have been motivated to make this modification because the use of voice mail to screen telephone calls is a convenience that is well known in the art.

6. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine in view of Chow *et. al.*, U.S. Patent No. 6,771,953.

Valentine discloses all of the limitations of claims 1 and 12, as outlined above.

Valentine does not expressly disclose the practice of displaying messages, which notify the user of a default operation being performed when an incoming telephone call is received, on the display of the mobile telephone.

Chow *et. al.* discloses steps for automatically returning an incoming telephone call. The telephone number associated with the incoming call is automatically saved, and the user is alerted with an automatic message, which notifies the user of the telephone number and the fact that this number has been stored, on the mobile telephone's display (Column 12 Lines 17-20, Fig. 39).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Valentine by providing for the automatic notification of the mobile telephone user of the telephone number associated with the incoming telephone call.



One of ordinary skill in the art would have been motivated to make this modification because of the convenience that is provided to the user when the originating telephone number of an incoming telephone call is known.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 703-605-4305. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Matthew Genack

Examiner

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12 November 2004



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